

AMENDMENT AND RESPONSE TO PAPER NO. 3

U.S. Application Serial No. 09/988,291

Attorney Docket No. 47004.000180

AMENDMENT TO THE CLAIMS

Please amend claims 59,63-66, 70-75, 77-80, 84-87, 95-97, 105 and 106 as follows. A clean copy of all pending claims is attached hereto.

59. (AMENDED) In a computer system for storing and manipulating merchant level customer purchase information received from a plurality of sources, the computer system comprising a storage device for storing the merchant level customer purchase information and a processor for placing the merchant level customer purchase information, a method for making targeting offers comprising the steps of:

receiving the merchant level customer purchase information;

organizing the merchant level customer purchase information within a predetermined organizational structure;

creating a customer preference based at least in part on the merchant level customer purchase information; and

forming a merchant level [an] offer for a customer based on at least one of the customer preference and the merchant level customer purchase information.

63. (AMENDED) The method of claim 62, further comprising the step of placing the merchant level customer purchase information into at least one of the plurality of categories and plurality of sub-categories using the processor.

64. (Amended) The method of claim 59, wherein the step of forming a merchant level [an] offer comprises forming an offer for goods and services.

65. (AMENDED) The method of claim 59, wherein the merchant level purchase information comprises at least an amount of purchase, a location of purchase, a merchant name, and a merchant category code.

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66. (AMENDED) The method of claim 59, wherein the merchant level customer purchase information comprises merchant text strings including a purchase amount and the step of creating a customer preference comprises reviewing merchant text strings.

70. (AMENDED) The method of claim 59, wherein the step of forming a merchant level [an] offer comprises matching selected words or characters with words or characters contained within the customer purchase information.

71. (AMENDED) The method of claim 59, wherein the merchant level customer purchase information comprises at least one of previous credit card transactions, customer profiles, customer applications, debit card purchases, and check purchases.

72. (AMENDED) The method of claim 59, wherein the merchant level customer purchase information comprises stored value purchase information.

73. (AMENDED) A system for storing and manipulating merchant level customer purchase information received from a plurality of sources, the system comprising:

means for receiving the merchant level customer purchase information, wherein the customer purchase information includes text strings;

means for organizing the merchant level customer purchase information within a predetermined organizational structure; and

means for forming a merchant level [an] offer for a customer based on a character search or word search of the text strings in the merchant level customer purchase information.

74. (AMENDED) The system of claim 73, further transmission means for extending the formed merchant level offer electronically through at least one of e-mail contact and a web page.

75. (AMENDED) The system of claim 73, further comprising transmission means for extending the formed merchant level offer through a medium comprising at least one of telephone calls and direct mail.

77. (AMENDED) The system of claim 73, further comprising processing means for placing the merchant level customer purchase information into at least one of the plurality of categories and plurality of sub-categories.

78. (AMENDED) The system of claim 73, means for forming a merchant level [an] offer comprise means for forming an offer for goods and services.

79. (AMENDED) The system of claim 73, wherein the merchant level purchase information comprises at least an amount of purchase, a location of purchase, a merchant name, and a merchant category code.

80. (AMENDED) The system of claim 73, wherein the merchant level customer purchase information comprises merchant text strings including a purchase amount and the means for creating a customer preference comprises searching means for reviewing merchant text strings.

84. (AMENDED) The system of claim 73, wherein the means for forming a merchant level [an] offer comprises matching means for matching selected words or characters with words or characters contained within the customer purchase information.

85. (AMENDED) The system of claim 73, wherein the merchant level customer purchase information comprises at least one of previous credit card transactions, customer profiles, customer applications, debit card purchases, and check purchases.

86. (AMENDED) The system of claim 73, wherein the merchant level customer purchase information comprises stored value information.

87. (AMENDED) A method for storing and manipulating merchant level customer purchase information received from a plurality of sources, the method comprising the steps of:

creating classified offers;

sorting multiple types of received merchant level customer information according to transaction type;

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storing the sorted merchant level customer information in a preference database;

combining sorted merchant level customer information relevant to each customer;

storing the combined merchant level customer information in a customer account database; and

matching the combined merchant level customer information with classified offers to form a match table for ranking classified offers with respect to each account.

95. **(AMENDED)** The method of claim 87, wherein the merchant level customer information comprises at least one of previous credit card transactions, customer profiles, customer applications, debit card purchases, and check purchases.

96. **(AMENDED)** The method of claim 87, wherein the merchant level customer information comprises stored value information.

97. **(AMENDED)** A system for storing and manipulating merchant level customer purchase information received from a plurality of sources, the system comprising:

a classification tool for creating classified offers;

a preference engine comprising a plurality of processors for receiving and sorting multiple types of merchant level customer information based on transaction type;

a preference database for receiving and storing sorted merchant level customer information from the preference engine;

a combiner for combining merchant level sorted customer information and storing the information for each customer in a customer account database; and

a match engine for combining the relevant merchant level customer information in the account database with classified offers from the classification tool in order to form a match table for ranking classified offers with respect to each customer account.

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105. *(AMENDED)* The method of claim 97, wherein the merchant level customer information comprises at least one of previous credit card transactions, customer profiles, customer applications, debit card purchases, and check purchases.

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106. *(AMENDED)* The method of claim 97, wherein the merchant level customer information comprises stored value information

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STATUS OF THE CLAIMS

Claims 59-106 are pending in the application.

Claims 59,63-66, 70-75, 77-80, 84-87, 95-97, 105 and 106 have been amended. No new matter was added with these amendments.

Claims 59-106 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,424,949 to Deaton *et al.* (“Deaton”) in view of U.S. Patent No. 6,327,574 to Kramer *et al.* (“Kramer”), U.S. Patent No. 6,298,348 to Eldering (“Eldering”) and U.S. Patent No. 6,377,936 to Henrick *et al.* (“Henrick”).

REJECTION UNDER 35 U.S.C. §103(a)

The Office Action has rejected claims 59-106 as allegedly being unpatentable in view of Deaton, Kramer, Eldering and Henrick. Applicants respectfully assert that the claims, as amended, are patentable over the combined references, as the proposed combination is improper, as it renders the references unsatisfactory for their intended use. The remaining combination fails to disclose every element of the invention and thus fails to set forth a *prima facie* case on obviousness.

The Combination Is Improper as It Renders the References Unsatisfactory

In addition, the Office Action asserts that Kramer and Henrick with either Deaton or Eldering disclose various aspects of the invention. The Office Action states that the motivation to combine Kramer and Deaton “is to teach a system that permits the analysis of historical consumer purchasing behavior.” The Office Action also states that the motivation to combine Henrick with Deaton and Kramer ... However, this motivation ignores the fact that key aspects of Kramer and Henrick would be rendered unsatisfactory by the proposed combination. “If a proposed modification would render the prior art invention being modified unsatisfactory for its

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intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

A key feature of Kramer is the privacy afford to users of the invention. Kramer specifically teaches that “[b]ecause of the nature and level of detail of the information available in the TIC model, the user of TIC will require a high degree of privacy. The privacy that TIC provides is that no information collected, generated or inferred by TIC ever leaves the user’s control. The data and inferences are used entirely on the users computer for the purpose of customizing and personalizing content for the user. With respect to TIC, personal information about the user only flows from external sources into the user computer (and the locally-controlled storage device). The user may use information presented by TIC to communicate back to content providers but that is done explicitly by the user independently of TIC.” Col. 5, line 62 through col. 6, line 7.

Thus, one of the key features of Kramer is the privacy afforded to an individual user. The very title of Kramer recites “Hierarchical Models of Consumer Attributes for Targeting Content in a **Privacy-Preserving Manner**” (emphasis added). These privacy concerns stand in stark contrast to the disclosures of Deaton and Eldering, which address none of these issues. Rather, Deaton and Eldering all maintain customer information at a location outside of the control of the customer. Thus, combining Kramer with either Deaton and Eldering would render Kramer unsatisfactory for its intended purpose.

Further, Henrick is directed toward data mining based on web-site usage. Abstract. Henrick also specifically notes that preserving consumer privacy is of specific concern. Abstract. Offers are made over the internet and market intelligence and customer profiles are all based on internet usage. Col. 4, lines 25-32. The Henrick invention “takes advantage of the unique customer knowledge of an Internet Service Provider (ISP)with respect to both the customers identity and their likes and dislikes, **while preserving the privacy of those customers**” (emphasis added). As with Kramer above, these privacy concerns stand in stark contrast to the disclosures of Deaton and Eldering, which address none of these issues. Deaton and Eldering all maintain customer information at a location outside of the control of the

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customer. Thus, combining Henrick with either Deaton and Eldering would render Kramer unsatisfactory for its intended purpose.

The Combination Does Not Disclose Every Element of the Claims

As the combination of Kramer and Henrick with Deaton and Henrick is clearly not proper or appropriate, the resulting combination of Deaton and Eldering does not disclose every element of the claimed invention. The claims of the present invention are directed toward gathering and manipulating merchant level customer purchase information. Specifically, claim 1, for example, recites “receiving the merchant level customer purchase information” and “organizing the merchant level customer purchase information.” Thus, the present invention is not concerned with individual products purchased, but the merchants at which a customer makes a purchase. The combination of Deaton, Eldering, Hendrick and Kramer do not disclose this element of the claims.

Both Deaton and Eldering are directed toward a single retailer. The disclosure of Deaton is essentially directed toward a system for a merchant to identifying risks with respect to accepting checks from a customer. Col. 4, lines 52-61. Thus, the system and process is to be used by an individual retailer. One feature of the system is then to target a customer at that retailer based on past purchases at that retailer. Col. 7, lines 31-50. There is no disclosure of regarding use of this system by more than one retailer, such as competing retailers, at the same time, or generating a customer profile based on the purchases at a number of different merchants, *e.g.*, on merchant level customer purchase information.

Eldering describes using actual product information, price and identification in creating a customer profile, as shown in Fig. 5. The invention described in Eldering is directed toward determining the individual products that a customer purchases. As set forth in Eldering, a “[p]rofiler 140 may be a retailer who collects data from its stores, but can also be a third party who contracts with consumer 100 and the retailer to receive point of purchase data and profile the consumer 100.” Col. 6, lines 9-12. As can be seen, Eldering is to be used by only one

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retailer to gather information for that retailer. There is no disclosure regarding use by more than one retailer, such as competing retailers, or generating a customer profile based on the purchases at a number of different merchants, *e.g.*, on merchant level customer purchase information.

Henrick, even if it were included, is directed toward data mining based on web-site usage. Abstract. Offers are made over the internet and market intelligence and customer profiles are all based on internet usage. Col. 4, lines 25-32. There is no disclosure in Henrick of any type of merchant level customer purchase information.

For these reasons, the combination of Deaton, Eldering, Henrick and Kramer is improper for rendering the references unsuitable for their intended use. Those references that can properly be combined fail to disclose every element of the claims, and thus fail to establish a *prima facie* case of obviousness.

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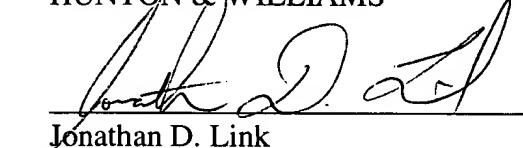
CONCLUSION

Applicants respectfully submit that this application, as amended, is in condition for allowance, and reconsideration and allowance of the application is respectfully requested. If the Examiner believes that prosecution might be advanced by discussing the application with Applicant's counsel, in person or over the telephone, we would welcome the opportunity to do so.

It is believed that no fees are due with this response. However, in the event any other fees are due, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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Dated: February 10, 2003